

**PATENT APPLICATION
IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicant: Contopanagos

Serial No: 10/074,293

Filing Date: 2/12/02

Confirmation No. 4912

Title: On-Chip Inductor Having Improved Quality Factor And Method Of Manufacture Thereof

Examiner: Andujar, Leonardo

Art Group: 2826

Docket No: BP 2108

Date: 3/27/09

Mail Stop:
Commissioner for Patents,
PO Box 1450
Alexandria, Virginia 22313

Petition from requirement for restriction pursuant to 37 CFR § 1.144

In an Office Action mailed on 11/25/08 regarding the above-captioned patent application, the Examiner re-affirmed the restriction of claims 1-15 in accordance with the following species classifications:

Species I: Figures 1A – 1B, claim 1 and 6;

Species II: Figures 2A – 2B, claim 2;

Species III: Figures 3A – 3B, claims 1, 2, 6, 9, and 10;

Species IV: Figures 4A – 4B, claims 1, 2, 3, 5, 6, 9, and 10;

Species V: Figure 5, claims 1, 2, 4, 6, 7, 9, 10, and 11;

Species VI: Figures 6A – 6B, claims 1, 2, 6, 8, 9, 10, and 12;

Species VII: Figures 7A – 7B, claims 1, 2, 4, 6, 7, 9, 10, and 11;

Species VIII: Figures 8A – 8B, claim 13.

The Examiner also noted that claims 14 and 15 appear not to read on any of the species.

In a response dated 12/4/07, the applicant specifically requested reconsideration of the restriction requirement. In the above referenced office action, the Examiner made the restriction requirement final. The applicant is thus petitioning the Director to

withdraw the restriction requirement. In support of this petition, the applicant states the following:

1. In the office action of 11/25/08, the Examiner indicated that claims 5, 8, and 12-15 are withdrawn and claims 1-4, 6, 7, and 9-11 are rejected.
2. The applicant is making a reply to the pending office action with a mailing date of 11/25/08;
3. The independent claims of the present patent application are:

Claim 1	Claim 9	Claim 13
<p>An on-chip inductor consisting of:</p> <p>at least one dielectric layer;</p> <p>at least one conductive winding on the at least one dielectric layer; and</p> <p>P-well having a major surface parallel to a major surface of the dielectric layer.</p>	<p>An on-chip inductor consisting of:</p> <p>at least one dielectric layer;</p> <p>at least one conductive winding on the at least one dielectric layer; and</p> <p>field oxide layer having a major surface parallel to a major surface of the dielectric layer.</p>	<p>An on-chip inductor consisting of:</p> <p>at least one dielectric layer;</p> <p>at least one conductive winding on the at least one dielectric layer; and</p> <p>poly silicon layer having a major surface parallel to a major surface of the dielectric layer.</p>

4. MPEP 806.04(d) states, in part, “in general, a generic claim ... must comprehend within its confines the organization covered in each of the species”, and MPEP 806.04 (c) states, in part, that “a claim may include two or more of the disclosed embodiments within the breadth and scope of definition (and thus be designated a *generic or genus claim*)”.
5. With the present grouping of species by the Examiner, independent claim 1 is listed in species groups I, III, IV, V, VI, and VII and independent claim 9 is listed in

species groups III, IV, V, VI, and VII. Each of dependent claims 2-8, which directly dependent from claim 1, are listed in one or more of species groups I, II, III, IV, V, VI, and VII. Each of dependent claims 10 - 12, which directly dependent from claim 9, are in one or more of species groups III, IV, V, VI, and VII.

Per the Examiner's own grouping, independent claims 1 and 9 are, by definition, genus claims.

6. 35 USC 112, fourth paragraph, states, in part, "a claim in dependent form shall contain ... a further limitation of the subject matter claimed ... [and] shall be construed to incorporate by reference all the limitations of the claim to which it refers".

7. In the present patent application, claims 2-8 properly dependent from claim 1, claims 10-12 properly dependent from claim 9, and claims 14 and 15 properly dependent from claim 13. Each independent claim corresponds to at least one disclosed embodiment of the invention. Thus, by definition, dependent claims 2-8, 10-12, and 14-15 provide additional limitations to the at least one embodiment covered by independent claims 1, 9, and 13.

As such, independent claims 1, 9, and 13 and dependent claims 2-8, 10-12, and 14-15 are providing varying breadth and/or scope of definition of the at least one disclosed embodiment.

8. MPEP 806.03 states, in part, "where the claims of an application define the same essential characteristics of a *single* disclosed embodiment of an invention, restriction there between should never be required. This is because the claims are but different definitions of the same disclosed subject matter, varying in breadth or scope of definition".

In the present patent application, claims 1, 9, and 13 are providing different definitions of an on-chip inductor having at least one dielectric layer, at least one conductive winding on the at least one dielectric layer, and a material (e.g., a P-well, a field oxide layer, or a poly silicon layer) having a major surface parallel to a major surface of the dielectric layer. Thus, the independent claims 1, 9, and 13 and their dependent claims 2-8, 10-12, 14, and 15 are providing varying breadth or scope of definition of an on-chip inductor.

9. For the foregoing reasons, the applicant respectfully requests that the Director withdraw the final restriction requirements of the present patent application and allow claims 1-15 to be prosecuted.

RESPECTFULLY SUBMITTED,

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CERTIFICATE OF MAILING
37 C.F.R. 1.8

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